Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. P. SHEPHERD
and
JOHN M. STEINKE

Appeal No. 1997-3073
Application No. 07/953,680

HEARD: DECEMBER 7, 2000

Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

BACKGROUND

The present application is a continuation-in-part (C-I-P) of Application No. 07/313,911. In a decision rendered in the 07/313,911 application, the Board affirmed the obviousness rejection of claims 1 through 12 that were directed to a method

of determining concentrations of constituent components of whole undiluted blood. A significant finding by the Board was that "Brown uses haemolysed blood" (Decision, page 11).

DECISION

The present appeal is from the final rejection of claims 1 through 44.

The disclosed invention now relates to a method of determining the concentrations of a plurality of constituent components of unaltered whole blood.

Claim 37 is illustrative of the claimed invention, and it reads as follows:

> 37. A method of determining the concentrations of a plurality of k constituent components of unaltered whole blood, k being an integer, comprising:
>
> generating a plurality of n different substantially monochromatic radiation wavelengths, where n is an integer and n > k, k of said n wavelengths having been selected to measure radiation absorption by said k constituent components, and n-k of said n wavelengths having been selected to compensate for errors due to n-k scattering factors in unaltered whole blood;
>
> irradiating a sample of unaltered whole blood with said n radiation wavelengths;
>
> detecting intensities of said n radiation wavelengths after passing through said sample of unaltered whole blood; and

calculating concentrations of said k constituent components of said sample of unaltered whole blood, corrected for the effects of radiation scattering, as a function of said detected intensities of said n radiation wavelengths.

The references[1] relied on by the examiner are:

Brown et al. (Brown) 4,134,678 Jan. 16, 1979

Anderson et al. (Anderson), "Light-absorbing and Scattering Properties of Non-haemolysed Blood," 12 Phy. Med. Biol., no. 2, 173-84 (1967).

Claims 1 through 44 stand rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness.

Claims 37 through 44 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of enablement and for lack of an adequate written description of the invention as is now claimed.

Claims 1, 10, 20 through 24, 26, 27, 34 through 37, 41 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.

Claims 2 through 9, 11 through 19, 25, 28 through 33, 38 through 40, 42 and 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderson.

Claims 1, 10, 20 through 24, 26, 27, 34 through 37, 41 and

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[1] The references to Anderson and Brown were applied by the examiner in the prior application.

43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Brown.

Claims 2 through 9, 11 through 19, 25, 28 through 33, 38 through 40, 42 and 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Brown.

Claims 1, 2, 5, 6, 9 through 21, 23, 24, 26, 27, 29 through 37 and 41 through 43 stand rejected under the doctrine of res judicata based upon the earlier adverse decision of the Board.

Reference is made to the briefs and the answer for the respective positions of the appellants and the examiner.

OPINION

For all of the reasons expressed by the appellants in the briefs, and for the additional reasons presented infra, all of the rejections are reversed.

The rejections under the first and second paragraphs of 35 U.S.C. § 112 are reversed because we agree with the appellants that the claimed invention does not have to be described in ipsis verbis in order to satisfy the requirements of 35 U.S.C. § 112 (Brief, pages 42 and 43), that the originally filed specification provides support for the claimed invention, especially the use of n measuring wavelengths to measure k constituent components with n>k in claims 37 through 44 (Specification, page 20; Brief, pages

43 through 46), and that there is nothing incompatible about choosing one subset of wavelengths for radiation absorbance and choosing another subset of wavelengths for radiation scattering (Brief, pages 43 through 49). Thus, we agree with appellants' argument (Brief, page 47) that "the existence of an absorbance subset of wavelengths, the members of which are selected to maximize absorbance relative to radiation scattering, along with a scattering subset of wavelengths, the members of which are selected to maximize the effects of scattering relative to absorbance, is completely compatible."

All of the prior art rejections are reversed because the applied references neither teach nor would they have suggested determining concentrations of unaltered whole blood via use of both wavelengths for radiation absorbance, and wavelengths for radiation scattering. As indicated supra, the Board found in the prior decision that Brown used "haemolysed blood" (i.e., altered blood). With respect to Anderson, we find that any whole blood that may have been involved in the experiments was altered by suspending the red cells in isotonic saline (page 177).

Turning lastly to the res judicata rejection, we find that the mere fact that the instant application is a C-I-P of the parent application means that the disclosures are not the same. The claims in this C-I-P application differ from the claims in the parent application, and the parent application did not have the eleven 37 CFR § 1.132 declarations.[2] In summary, the res judicata rejection is reversed because the issues in the parent application differ from the issues in the application before us on appeal (Brief, pages 35 through 42).

[2] In view of the reversal of all of the prior art rejections, we will not offer any comments concerning the merits of the declarations.

DECISION

All of the rejections have been reversed. Accordingly, the decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge)
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) BOARD OF PATENT
KENNETH W. HAIRSTON)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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